Remarks

In the Office Action dated December 15, 2003, the Examiner rejected claims 1-21 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,646,917 to Miyoshi, et al. (hereinafter Miyoshi) in view of U.S. Patent No. 5,486,727 to Heidelberg, et al. (hereinafter Heidelberg). Applicants respectfully request the Examiner to reconsider the claims and withdraw the rejections.

Independent claim 1 provides an automated library system having at least one robot, a secondary coil disposed on each of the at least one robots respectively and positioned to inductively couple at least a portion of an alternating current in at least one primary coil to the at least one robot, and the at least one robot comprises a drive mechanism configured to move the robot about within the automated library system. Independent claims 10 and 17 provide similar recitations. A robot comprising a drive mechanism configured to move the robot about within an automated library system is not taught, disclosed or suggested by Miyoshi and Heidelberg, alone or in combination.

In particular, Miyoshi teaches a horizontal carrier that has a magnet to form a magnetic field passing through a plurality of coils that are sequentially excited to move the carrier in the moving direction. (Miyoshi, Abstract). Miyoshi further teaches a guide rail device is adapted to move the carrier by a magnetic force generated between the guide rail device and the carrier. (Miyoshi, Fig. 5 and col. 3, ll. 64-67). One of ordinary skill in the art would understand that inductively coupling, as presently claimed, is a transfer of energy from a primary coil to a secondary coil. However, Miyoshi teaches a magnetic force to move the carrier (i.e., the repulsion between the magnet 184 and the coil unit 173-1). (See, Miyoshi at col. 4, ll. 6-12). Nowhere does Miyoshi teach, disclose or suggest a robot comprising a drive mechanism configured to move the robot about within an automated library system as provided in the presently pending invention.

In particular, in the carrier system for carrying mediums taught by Miyoshi, the moving force of the carrier is caused by the repulsive force between the magnet on the carrier

and the coil on the guide rails. One of ordinary skill in the art would understand that the carrier taught by Miyoshi is a driven element (i.e., a mechanism driven by the repulsive force). Therefore, Miyoshi fails to teach or suggest an automated library system having at least one robot, a secondary coil disposed on each of the at least one robots respectively and positioned to inductively couple at least a portion of an alternating current in at least one primary coil to the at least one robot, and the at least one robot comprises a drive mechanism configured to move the robot about within the automated library system, as set forth in the presently pending independent claims.

Heidelberg teaches a linear accelerator that has at least one longitudinal stator section that defines a linear path of movement and that comprises several stator coils as well as a rotor with several rotor coils that can be accelerated along the path of movement. The design and arrangement of the rotor coils and stator coils allow a circular magnetic field to be generated, with the result that the rotor is axially accelerated. (Heidelberg, Abstract). One of ordinary skill in the art would understand that the rotor taught by Heidelberg is a driven element (i.e., a mechanism driven by the magnetic field). Nowhere does Heidelberg teach, disclose or suggest a robot comprising a drive mechanism configured to move the robot about within an automated library system as provided in the presently pending invention. As such, Heidelberg fails to cure the deficiencies of Miyoshi.

Nowhere does any combination of Miyoshi and Heidelberg teach, disclose or suggest a robot comprising a drive mechanism configured to move the robot about within an automated library system as provided in the presently pending invention. Since the cited references, alone or in combination, fail to teach, disclose or suggest the claimed invention, a *prima facie* case of obviousness under 35 U.S.C. § 103(a) has not been established, and the rejection should be withdrawn.

Furthermore, regarding independent claim 10, that claim provides the secondary coil is electrically connected to an electronics circuit. The electronics circuit is disposed on the frame and is in communication with the drive mechanism and the automated library system

to facilitate control of the drive mechanism in accordance with commands from the controller. Neither of the prior art references cited by the Examiner, alone or in combination, teach or suggest a robot comprising an electronic circuit that is in communication with a drive mechanism and an automated library system to facilitate control of the drive mechanism in accordance with commands from a library system controller, as set forth in claim 10.

Regarding claims which depend from independent claims 1, 10 and 17, Applicants contend that these claims are patentable for at least the same reasons that claims 1, 10 and 17 are patentable. Moreover, Applicants contend these claims recite further limitations, in addition to the limitations of claims 1, 10 and 17, which render these claims additionally patentable.

Applicants have made a *bona fide* effort to respond to the Examiner's rejections in advancing the prosecution of this case. Applicants believe all formal and substantive requirements for patentability have been met and that this case is in condition for allowance, which action is respectfully requested.

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The Examiner is respectfully requested to telephone the undersigned to discuss prompt resolution of any remaining issues necessary to place this case in condition for allowance.

Respectfully submitted,
David W. Miller, et al.

By _____
Thomas W. Saur
Reg. No. 45,075
Attorney/Agent for Applicant

Date: February 9, 2004

BROOKS KUSHMAN P.C.
1000 Town Center, 22nd Floor
Southfield, MI 48075-1238
Phone: 248-358-4400
Fax: 248-358-3351